

**Appl. No. 10/019,894
Att. Docket No. 10191/2142
Response To Final Office Action of 09/29/03**

REMARKS

Claims 6 to 10 are now pending.

Claim 9 has been amended to correct an informality.

Applicant respectfully requests reconsideration of the present application in view of this response.

It is believed that this Amendment does not raise new issues that would require further consideration and/or search, and also does not raise the issue of new matter. It is also believed and respectfully submitted that this Amendment places the application in better form for appeal by materially reducing or simplifying the issues for appeal.

It is respectfully requested that the Examiner acknowledge the foreign priority claim and the receipt of the certified copies of the priority documents as acknowledged by the March 19, 2002 notification paper.

It is respectfully requested that the Examiner withdraw the finality of the Office Action since it was issued as a Final Action even though there was no amendment that necessitated such finality. It is respectfully submitted that another non-final Office Action should have been issued since the Examiner cited and considered a new reference, namely the Hessing reference, to reject claim 6 (as well as claims 7 to 10).

With respect to paragraph two (2) of the Office Action, claims 6 to 10 were rejected under 35 U.S.C. 103(a) as unpatentable over Roeseler et al., U.S. Patent No. 6,317,684, in view of Hessing, U.S. Patent No. 6,334,089.

For a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must disclose or suggest each claim feature. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Claim 6 includes the features of “determining a route in the on-board vehicle navigation system in a vehicle” such that “only delta information representing required necessary deviations from a previously determined route for driving an alternative section of the route is transmitted from the control center to the vehicle navigation system.” Claim 8 includes the feature of “distributing the motor vehicle traffic flow among a plurality of detour segments in a controlled manner when there is a traffic problem and a plurality of feasible

**Appl. No. 10/019,894
Att. Docket No. 10191/2142
Response To Final Office Action of 09/29/03**

detour routes are available.” Claim 9 includes the feature of a “vehicle navigation system for use in a vehicle”, including “a determining arrangement to determine a route in the vehicle navigation system” and “a transmitting arrangement to transmit information from a control center to the vehicle navigation system for use in providing optimized route planning, wherein only delta information representing required necessary deviations from a previously determined route for driving an alternative section of the route is transmitted from the control center to the vehicle navigation system.” Claim 10 includes the feature of “distributing the motor vehicle traffic flow among a plurality of detour segments in a controlled manner when there is a traffic problem and a plurality of feasible detour routes are available.”

As to the rejections of claims 6 and 9, neither Roeseler nor Hessing discloses that “only delta information representing required necessary deviations from a previously determined route for driving an alternative section of the route is transmitted from the control center to the vehicle navigation system” as recited in claims 6 and 9. In fact, Roeseler states that a “route planning and navigation unit may then re-plan the route based on the new traffic and road condition and the new navigation instructions will be sent to the caller”. (See Roeseler, col. 3, lines 41 to 45). A complete alternative route based on new traffic and road conditions is transmitted to the caller in Roeseler. In addition, Hessing states that after the start of the journey from the starting point A, traffic information is processed and considered in setting up the actual or updated route to be traveled. (See Hessing, col. 4, lines 53 to 56). Also, “[t]he internal route that is set up by the central server 12 can change during the actual travel over the route 1 without the driver’s knowledge.” (See Hessing, col. 4, lines 56 to 58). The route in Hessing is changed in response to traffic conditions such that the complete route is updated before the central server continues to transmit the route to the driver. (See Hessing, col. 4, lines 51 to 64). Neither Roeseler nor Hessing disclose limiting the transmission of route data to transmitting only difference data (delta information), as recited in the context of claims 6 and 9.

Furthermore, the Office Action states that “Roeseler does not disclose determining a route in the on-board vehicle navigation system in a vehicle. However, Hessing teaches it in column 3.” (See Office Action, page 3). In actuality, Hessing states that a “central server 12 conducts the information, namely the aforementioned destination B, to a processor 17, which

Appl. No. 10/019,894
Att. Docket No. 10191/2142
Response To Final Office Action of 09/29/03

computes an optimum route 16 for reaching the destination”, and that the “route 16 is transmitted to the vehicle piecewise by means of the communications link 14”. (See Hessing, col. 3, lines 48 to 59). Thus, Hessing only indicates that a route is determined by a processor included in the central server (see Hessing, Figure 1a), so that it does not disclose that an on-board vehicle navigation system determines a route as recited in the context of claims 6 and 9.

It is respectfully submitted that even if it were proper to combine Roeseler and Hessing, the resulting combination would not render obvious claims 6 and 9, so that these claims are allowable.

In particular, it is believed and respectfully submitted that the navigation device of the Hessing reference is not designed to calculate a route in the vehicle by itself. The difference with respect to the Roeseler reference is that the route is not transmitted to the vehicle system in its entirety, but bit by bit in different sections. Accordingly, claim 6 is allowable over these references, even if they are combined.

Claim 7 depends on claim 6, and is therefore allowable at least for the same reasons as claim 6.

As further regards claim 7, there is also no suggestion of its subject matter since the cited sections of the Hessing and Roeseler references do not indicate that database-type information is transmitted to the master station. As to the two systems of the two cited references, it is only indicated that a database is only provided in the service center and that a route is calculated only at the service center. Accordingly, claim 7 is allowable for this further reason.

As to the rejections of claims 8 and 10, Roeseler states that a “route planning and navigation unit may then re-plan the route based on the new traffic and road condition and the new navigation instructions will be sent to the caller”. (See Roeseler, col. 3, lines 41 to 45). Also, Hessing states that “traffic information 18 generated since the start of the journey from the starting point A can be processed by the processor 17 and considered in set up the actual or updated route 16 to be traveled. The internal route that is set up by the central server 12 can change during the actual travel over the route 16 without the driver's knowledge.” (See Hessing, col. 4, lines 53 to 56). Both Roeseler and Hessing indicate that in response to

**Appl. No. 10/019,894
Att. Docket No. 10191/2142
Response To Final Office Action of 09/29/03**

updated traffic information, a re-planned route is sent to the caller without consideration of alternative detour routes. Neither Roeseler nor Hessing disclose that distribution of motor vehicle traffic flow among a plurality of detour segments in a controlled manner when there is a traffic problem and a plurality of feasible detour routes are available, as recited in the context of claims 8 and 10.

It is therefore respectfully submitted that the combination of Roeseler and Hessing does not render obvious claims 8 and 10.

As further regard the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). The prior art simply does not address the problems met by the subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action’s assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

**Appl. No. 10/019,894
Att. Docket No. 10191/2142
Response To Final Office Action of 09/29/03**

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is the case here since it is respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, there have been no such findings to establish that the features discussed above of the

**Appl. No. 10/019,894
Att. Docket No. 10191/2142
Response To Final Office Action of 09/29/03**

rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the rejected claims.

More recent still, in the case of *In re Lee*, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

[The] "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation.

**Appl. No. 10/019,894
Att. Docket No. 10191/2142
Response To Final Office Action of 09/29/03**

[The] Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

In summary, it is respectfully submitted that claims 6 to 10 are allowable.

CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claims 6 to 10 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Dated: 1/6/2004

Respectfully submitted,
KENYON & KENYON
By: Richard L. Mayer *(Reg. No. 22,490)*

One Broadway
New York, New York 10004
(212) 425-7200

(Signature)
33,825
Aaron C.
O'Reilly

CUSTOMER NO. 26646

642939